

Remarks**35 USC § 102 Rejection**

Claims 1-2, 6-7, 11-12, 15, 17-19 and 26-28 are rejected under 35 USC 102(b) over Israel (US 4,887,409). Disappointingly, the Examiner has maintained this rejection, almost verbatim. At issue, claim 1 explicitly recites "one or more extruded powders". The Examiner maintains:

With regard to claims 1-2, Israel et al discloses a case (figs. 1-2) comprising a surface (28) having one or more grooves (recess 26 fig. 1), openings toward the tops of the one or more grooves and at least one cosmetic powder (40) disposing in the groove. The method used to form the powders by extruding is given no patentable weight.

The Examiner calls it a "cosmetic powder" while the reference is quite clear that only compressed cosmetic powders are of concern. In contrast, applicant's claim 1 recites an extruded powder. By saying, "The method used to form the powders by extruding is given no patentable weight," the Examiner is saying that a compressed powder is not different from an extruded powder. If the Examiner is not saying this, then a 102 rejection is completely misplaced here, because it is axiomatic that a 102 rejection is only proper when each and every claim element is found in a single prior art reference. If the Examiner understands that an extruded powder is different from a pressed powder then she must agree that this 102 rejection is inappropriate because Israel has nothing to say about extruded powders. Therefore, applicant assumes that the Examiner is maintaining that a compressed powder is not different from an extruded powder. During the first office action it was thoroughly unclear to the applicant why the Examiner would adopt such a position. In the present office action the Examiner has offered the following:

Applicant has argued the difference in compositions of extruded powders and pressed powders; however, Applicant fails to show the different amounts of binders used in pressed and extruded powders... The only difference between the final extruded powder and pressed powder appears to be a degree of binder used and the disclosure is not specific as to what this difference in the degree of binder used is; without this teaching the degree of binder used is broadly claimed and is held to be met by the prior art.

The Examiner maintains that the only difference between extruded and pressed powders is in the degree of binder. The Examiner has not told the Applicant why she believes this to be true. In fact, it is not true. In the specification as filed and in

response to the first office action the applicant pointed out several differences between extruded and pressed powders. One of those was the degree of binder used. Applicant does not know why the Examiner has focused exclusively on this difference. In some sense it does not matter. Even if this is the only difference in the way each powder is formulated (and it isn't), that has nothing to do with applicant's claim 1 which recites the powder not the method of making. Even if the only difference in composition is in degree of binder, this does not mean that the two powders are anything alike. As any chemist and formulator knows, what can appear to be a minor difference in formulation on paper can lead to a totally different result.

Consider the differences between iron and steel, for example. The differences between iron and steel arise from the amounts of carbon contained in the metals. Wrought iron contains less than 0.1% carbon. It is a ductile metal that can be heated and welded, but not hardened; it can be softened but not made fluid by an ordinary furnace. Increasing the carbon content causes the metal to develop the qualities of steel. At 0.65% carbon, the metal increases its tensile and compressive strength. It can be welded and remains ductile. It can be hardened and will flow at an easily obtainable temperature. Tool steel is obtained at 1% carbon. When the carbon content reaches 2% or greater the metal loses its ductility and cannot be welded or tempered. This is cast iron. The properties of the ore vary dramatically (with dramatic results to civilization!) because of minor differences in the amount of one ingredient. Would it really be the Examiner's position that a claim recitation of steel may be anticipated by a reference that teaches iron because no patentable weight should be given to the method of making the metal? Applicant doubts this and sees no difference in the present situation.

Whatever the differences between pressed and extruded powders in composition or manufacture, the fact is the two have widely different properties which were discussed in the specification as filed and in response to first office action. The differences are so well understood by a person of ordinary skill in the art that the mere mention of the terms pressed powder or extruded powder conjures in the mind of a person of ordinary skill two separate forms of powder composition. Why else would there be the two terms, pressed powder and extruded powder, commonly applied,

except to distinguish between these two very distinguishable forms? Even if binder level was the only difference, the properties of the final products are so different, like iron and steel, that they are separately exploitable, entirely distinguishable from each other, and therefore, patentably distinct. For some inexplicable reason, the Examiner has focused on the notion that the two forms may sometimes be similar in composition or perhaps the Examiner has focused on the fact that both forms are a type of cosmetic powder and thought that they are interchangeable. But the Examiner is wrong in this. The fact is, extruded powders and pressed powders have art recognized differences, so that a recitation of extruded powder clearly distinguishes from a pressed powder. The Examiner has provided no evidence or rationale to support her position that an extruded powder should ever be anticipated by a pressed powder.

The applicant took some pains in the specification to explain the differences between extruded powders and pressed powders. They are generally different in composition and each has advantages and disadvantages over the other, depending on the situation.

**1. In terms of composition**, pressed powders are formulated with comparatively little aqueous binder. This is possible because pressed powders are supported in a pan and receive a high degree of compaction. In contrast, extruded powders do not have the degree of compaction and are not supported in a receptacle. Therefore, extruded powders require a substantial aqueous binder phase to hold the end product together.

**The Examiner's assertion that applicant's specification does not provide the teaching of what are the relative amounts of binder is irrelevant. A person of ordinary skill in the art knows that pressed powders and extruded powders possess different properties. A person skilled in the art knows that the two forms behave differently and that you can do and expect certain things from one form that you cannot expect from the other. The actual percentages of binder is irrelevant to an anticipation discussion.**

**2. Also**, pressed powder material is pulverized prior to filling and pressing. This places limitations on the composition of the pressed powder which are not present in extruded powders because the formulator is excluded from including any materials that would be ruined by the pulverizing process. For example, pearl pigments

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are unsuitable for pressed powder formulations. In contrast, an extruded powder is not pulverized before extrusion and therefore may contain a wider variety of relatively large materials, such as pearl. **This is another difference in composition** of which the person of ordinary skill in the art is well aware.

3. Generally, the two forms have very different properties. As explained in the specification, extruded powder sticks are generally formulated to meet conflicting requirements, i.e., possess cohesive strength sufficient to prevent breakage when being drawn over the skin, while being soft enough to yield adequate "pay-off". Pay-off refers to the stick's ability to deposit product as it is drawn over a surface, i.e., the skin. In contrast, pressed powders could not generally be drawn over the skin because they do not possess sufficient cohesive strength to prevent breakage. Also, pressed powders do not generally have the same pay-off because pressed powders are used with an applicator which lifts the powder from the container so that pay-off is not a factor.

Applicant's point is that extruded powders and pressed powders are different. Any person of ordinary skill in the art, not to mention any regular user of cosmetic powder products, knows that they are different. Therefore, applicant's claim 1 cannot be anticipated by a reference that is only concerned with compressed powders. Claim 1 is not anticipated by Israel, because Israel does not recite all of the elements of claim 1.

To constitute an anticipation, a reference must contain **each and every element** of the rejected claim within its teachings; absence of a claim element from a prior art reference **negates** anticipation. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 224 USPQ 409 (Fed. Cir. 1984).

It is well established that a rejection for anticipation under section 102 requires that **each and every** limitation of the claimed invention be disclosed in a single prior art reference. *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994).

Israel makes no mention of an extruded powder, let alone an extruded powder disposed in a groove. Israel at great length describes the flowable powders being loaded into a pan and subsequently pressed to give the powder firmness. But, as discussed, pressed powders are not the same as extruded powders. Based on the absence of extruded powders in Israel, Israel does not anticipate the present invention. Applicant requests reconsideration of this rejection. Since claim 1 is not anticipated by Israel, neither are dependent claims 2-28. However, regarding claim 27, applicant

wishes to point out that Israel does not disclose a cover which is friction fit onto the surface. The cover 14 in Israel is secured by a fastener made up of detent 18 and slot 20. For this reason, claim 27 is further not anticipated by Israel.

### **35 USC § 103 Rejections**

A. Claims 3-5 stand rejected as being unpatentable over Israel in view of von Kleinsorgen. The Examiner wrote:

With regard to claims 3-5, Israel et al discloses a case comprising all the claimed limitations in claim 1 as discussed above except for the powders being not all the same color and chemical composition...Von Kleinsorgen discloses a cosmetic stick (fig. 1) comprising at least two powders (12, 13) being not all the same color and chemical composition (col. 4, lines 19-22)...It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the particular powder as taught by von Kleinsorgen into the case of Israel for the purpose of providing a plurality of different colors."

There are a number of flaws in the Examiner's statement. Firstly, Israel certainly does disclose powders of different colors (col. 1, lines 20-21; col. 2, line 8, col. 3, lines 54-55, col. 5, line 66 - col. 6, line 1) and/or different chemical compositions (col. 6, lines 1-4). There is really no need to use von Kleinsorgen to introduce the concept of multiple colors or chemical compositions. This, however, proves to be irrelevant because the Examiner's initial statement, that Israel discloses the limitations of claim 1, has already been shown to be false, there being no extruded powders in Israel. Obviously then, even though von Kleinsorgen discloses multicolored powders and powders of different chemical compositions, claims 3-5 are still not rendered obvious. Notwithstanding the above, von Kleinsorgen does disclose "powder sticks" and applicant wishes to make some further remarks about the combination of Israel in view of von Kleinsorgen.

#### **The combination does not teach all elements of claims 3-5**

Firstly, the powder sticks of von Kleinsorgen are nowhere disclosed to be extruded powders and, as already noted, extruded powders are not disclosed in Israel. Therefore, the combination of Israel in view of von Kleinsorgen does not teach or suggest the extruded powders recited in claims 3-5. This alone negates the finding of obviousness, but other reasons exist as well.

#### **The combination lacks motivation to combine or modify**

The Examiner has not explained what the motivation would be to modify Israel with the teachings of von Kleinsorgen. In fact no such motivation exists. This is clear when the references are viewed **in their entirety** as it is the Examiner's responsibility to do. Why, after reading von Kleinsorgen, would a person of ordinary skill in the art replace the pressed powders of Israel with the powder sticks of von Kleinsorgen? The Examiner has not placed on the record any reasoned explanation. Furthermore, the references do not teach or suggest any advantage to combining Israel and von Kleinsorgen. Actually, when read for all they disclose, the references teach away from their being combined. The Israel reference itself teaches that his invention is suitable only for compressed powders:

The articles contemplated by the present invention generally are sold to consumers in small portable containers commonly referred to as "compacts" in which the cosmetic article is stored as a **compressed powder** prior to application to the surface of the skin. The cosmetic article may comprise ... any other known cosmetic material **susceptible of being formed and stored in compressed powder mode**. Even more particularly, the cosmetic articles contemplated comprise multiple segments of cosmetic material ... reposing in individual pans..." (col. 1, lines 9-21).

In contrast, von Kleinsorgen teaches the advantages of powder sticks **over compressed powders in pans**.

...powder sticks or pencils which are used for decorative cosmetic purposes differ from the powder compacts or powder blocks insofar as a powder stick or pencil is used to apply the powder directly to the ski[n] by rubbing the actual powder pencil against the surface of the skin.... A considerable advantage of powder pencils of that kind is that the powder material can be applied to the skin in a substantially more accurate and more finely controlled manner...

Clearly, von Kleinsorgen is specifically differentiating his powder sticks from compressed powders in pans, like those of Israel. Therefore, von Kleinsorgen teaches away from Israel. This is a very strong motivation not to combine the references.

The combination lacks expectation of success

Furthermore, there is no expectation of success because the proposed combination cannot be done successfully. The Examiner wrote:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the particular powder as taught by von Kleinsorgen into the case of Israel for the purpose of providing a plurality of different colors."

Employing "the particular powder as taught by von Kleinsorgen into the case of Israel" will not work. The essence of Israel is a process for filling and pressing loose

powder in a single operation. The Examiner cannot simply ignore this portion of Israel. It is absolutely necessary for the Examiner to **consider the reference as a whole**. If you put the powder sticks of von Kleinsorgen into the filling and pressing machinery of Israel several things will happen. Firstly, the powder sticks will be destroyed so as not to be powder sticks anymore, rendering von Kleinsorgen inoperative for its intended purpose. In fact, if anything, the result will be the powder compacts and powder blocks from which von Kleinsorgen specifically differentiated his invention. Secondly, the powder sticks of von Kleinsorgen are comprised of stick portions of differing colors and chemical compositions stuck together. If such a powder stick is put into the machine of Israel, where it will be compressed and destroyed, the colors and formulae will be mashed together so that what comes out is not multiple powders of different colors and compositions but some unusable conglomerate. Also, the chemical compositions of von Kleinsorgen are suitable for powder sticks while those of Israel are suitable for compacts. A person of ordinary skill in the art will appreciate that these formulations have basic differences that make them suitable for their respective end use. Therefore, a person of ordinary skill in the art would not be expected to simply substitute the powder stick compositions of von Kleinsorgen into the compressed powder machinery of Israel.

In conclusion, when both references are read for all they disclose, it is clear that there is no meaningful way to combine Israel and von Kleinsorgen. The combination does not teach or suggest all of the elements of claims 3-5, the combination lacks motivation, as well as expectation of success. In fact, the references teach away from the combination and the office action fails to place on the record any reasoned statement in support of the combination. For these reasons, reconsideration of this rejection is respectfully requested.

**B.** Claims 8-9 and 13-14 stand rejected as being unpatentable over Israel et al in view of Schefer. The Examiner wrote:

With regard to claims 13-14, Israel et al discloses a case comprising all the claimed limitations in claim 1 as discussed above ...

Based on the foregoing discussion, the Examiner's initial position, that claim 1, from which claims 8-9 and 13-14 depend, is anticipated by Israel is incorrect.

Therefore, when the Examiner relies on Schefer to introduce the additional elements of claims 8-9 and 13-14, the combination still fails to teach or suggest recited elements of claim 1. Specifically, the combination of Israel and Schefer fails to teach an extruded powder, let alone an extruded powder disposed in a groove. Differences between extruded and pressed powders have been discussed above, particularly noting that those differences suggest not to use an extruded powder in the manner revealed in the applicant's specification. Nothing in Schefer changes that fact. Schefer does not specifically say what are the physical forms of the cosmetics contemplated and therefore does not disclose an extruded powder. However, Schefer does require the cosmetic material 40 to be located in cosmetic inserts 24 (col. 3, lines 25-26). Regarding these inserts, the only embodiment disclosed in Schefer are pans of the type usually encountered in pressed powder cosmetic compacts, which, to the applicant's knowledge, are not necessary to hold extruded powders. Therefore, it must be understood that Schefer in no way contemplates doing what the applicant has done, i.e. disposing extruded powder in a groove. Since neither Israel nor Schefer alone or in combination discloses all the elements of claim 1, from which claims 8-9 and 13-14 depend, this rejection must be withdrawn.

Furthermore, claim 8 requires a portion of the powders to rise above the surface.

On this point the Examiner has written:

Schefer discloses a cosmetic compact case (fig. 6) comprising a surface (30) having a plurality of grooves, a portion of cosmetic powder (24) rises above the surface (fig. 6)...

Respectfully, the Examiner is mistaken in this observation. There are two possible interpretations. If surface 30 (called "recess 30" in Schefer) is interpreted as having grooves, then ribs 36 must be included as part of surface 30 because ribs 36 are what define the grooves or "areas" 38 into which the individual cosmetic inserts 24 are received (see col. 3, lines 15-17). If this is not done, then there is no way to say that surface 30 has grooves. However, when interpreted this way, then the cosmetic material 24 of Schefer does not rise above the surface, i.e. top edge of the ribs 36, which is clear in figure 6. Alternatively, if surface 30 is not interpreted to include ribs 36, then surface 30 does not have grooves. Furthermore, Israel does not disclose a portion



of the powders rising above the surface. Therefore, in either interpretation of Schefer, claim 8 is not rendered obvious by the combination of Israel and Schefer.

Furthermore, claim 9 requires forty percent or more of each extruded powder to rise above the surface. On this point the Examiner has written:

...it would also have been an obvious matter to one having an ordinary skill in the art at the time the invention was made to construct forty percent or more of each powder rises above the surface, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

The Examiner is misguided, here, as explained in MPEP 2144.05 II. B, entitled "Only Result-Effective Variables Can Be Optimized"

A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

The degree to which the powder rises above the surface is a variable **never** before recognized in the art as being results effective. This is obvious when one considers that extruded powders have never been used in the manner that the applicant is claiming. With applicant's invention, **an applicator brush is drawn in one motion, without lifting the brush, across several extruded powders.** Neither extruded powders nor pressed powder compacts are ordinarily used in this way. With a pressed powder compact, a brush is moved over one color in the compact case and then applied to the skin. When mixing colors is desired a brush is moved over one color in the compact case, then the brush is lifted and placed on a second color in the case and then applied to the skin. Alternatively, the color mixing is done on the skin by applying the powders in succession. In either case, it is not all typical to draw the applicator across different powders in one motion, without lifting. **Because of this fact,** the powders in pressed powder compacts do not ordinarily rise above the surface in question. Generally, having the powder rise above the pan surface is not desirable because the powder is less protected and more likely to break off in the case, making a mess. Pans are typically sized so that the surface of the powder is below the top of the pan. For this reason, an ordinary person of skill in the art would not recognize the degree to which the powder rises above the surface as a results effective variable. Powder above the surface is not ordinarily desired. And even if it was, that pertains to pressed powders and not to extruded powders, which have never been used in this

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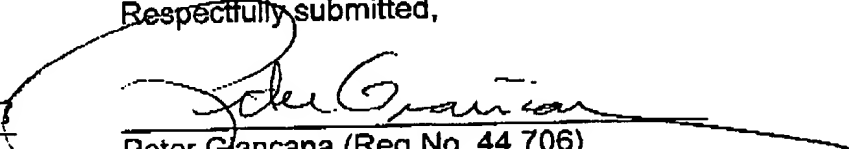
manner before. Prior to applicant's invention a person of ordinary skill in the art would not understand the meaning of the degree to which an extruded powder rises above the surface of the case, because extruded powders were never reposed in this type of case, as the applicant has done. It must now be admitted that the degree to which the extruded powder rises above the surface is not recognized in the art as a results effective variable and therefore, a person of ordinary skill in the art could never be expected to come to the value of 40% by routine experimentation. The value of 40% is newly disclosed as a results effective amount in the applicant's disclosure. Reconsideration of the rejection of claim 9 is requested.

C. Claims 20-25 stand rejected as being unpatentable over Israel et al in view of Gueret (US 5,713,471). Once again the Examiner has erroneously relied upon the notion that Israel anticipates applicant's claim 1, from which depend claims 20-25. On that inappropriate foundation, the Examiner attempts to build an obviousness rejection. However, since claim 1 is not anticipated by Israel, this rejection cannot stand. Furthermore, claim 1 is not rendered obvious by the combination of Israel and Gueret because neither reference discloses extruded powders let alone extruded powders disposed in grooves. Since claims 20-25 depend from a non-obvious claim, they too must be non-obvious.

Regarding all of the references cited by the Examiner, even those not relied upon but which were included to show the state of the art, the applicant wishes to point out that none of them discloses extruded powders disposed in grooves as defined in the present claims. All rejections having been addressed, allowance of all pending claims is requested.

Respectfully submitted,

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